REMARKS

The Office Action dated February 9, 2006, has been received and carefully noted. The amendments made herein and the following remarks are submitted as a full and complete response thereto.

Claims 1 and 21 have been amended. Claims 34-46 have been canceled. Claims 1-33 are therefore pending in the present application and are respectfully submitted for consideration.

I.   <u>35 U.S.C. § 101</u>

Claims 1-21 were rejected under 35 U.S.C. § 101 because, according to the Examiner, they appear to be directed merely to an abstract idea that would not result in a useful, concrete, and tangible result. Responsive to this rejection, claims 1 and 21 were amended to claim the feature of prompting for a response based on the iterative revision of the prioritization of the at least one field. If any additional amendment is necessary to overcome this rejection, the Examiner is requested to contact the Applicant's undersigned representative.

Claims 1-20 were rejected under 35 U.S.C. § 101 because the Examiner asserted that the claimed invention appeared to be comprised of software alone without claiming associated computer hardware required for execution is not supported by either a specific or a substantial utility. The Applicants respectfully traverse this rejection, as follows.

With respect to claims 1-21, the Applicants respectfully submit that these claims are directed to statutory subject matter under 35 U.S.C. §101.

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The statute states, in relevant part, "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor . . ." *See* 35 U.S.C. §101. A "process" is defined to encompass "[a] process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material." *See* 35 U.S.C. § 100(b).

Claims 1-21 of the present application are directed to "[a] method for providing assistance with populating an automated document that includes at least one field." Claims 21 and 22 is directed to "[a] system for providing interactive assistance with populating a customized document that includes at least one field" similar to the method of claim 1. The Applicants respectfully submit that each of claims 1-21 is directed to a method or system, which is included in the statutory definition of a "process," and is therefore expressly included in one of the categories of statutory subject matter provided in 35 U.S.C. §101.

Furthermore, the Applicants submit that the subject matter claimed in claims 1-21 does not fall within the judicially defined exceptions to patentable subject matter, i.e., laws of nature, natural phenomena, or abstract ideas. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

There is no reason why software alone is not patentable. This rejection appears to require a technological requirement. However, in *Ex parte Lundgren*, the Board of Patent Appeals and Interferences ("BPAI") expressly rejected the "technological arts" test, to which this rejection appears analogous, holding that "there is currently no

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judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." *See* 2004 WL 3561262 (Bd.Pat.App & Interf. April 20, 2004), at *5.

Claim 21 was rejected under 35 U.S.C. § 101 because, according to the Examiner, the claim does not require any computer hardware to implement the claimed invention. The Applicants respectfully traverse this rejection and submit that "means" can be either software and/or hardware.

For at least these reasons, the Applicants respectfully submit that claims 1-21, as amended, are directed to statutory subject matter as defined by 35 U.S.C. § 101, and request withdrawal of the rejection.

II.   35 U.S.C. § 102(b)

Claims 1-33 were rejected under 35 U.S.C. § 102(b) as being anticipated by Roper (U.S. Patent No. 6,270,351). To the extent that this rejection remains applicable to the claims, as amended, it is respectfully traversed.

Applicant's invention as now set forth in amended claim 1 is directed to a method for providing interactive assistance with populating an automated document that includes at least one field, iteratively revising the prioritization of all of at least one field upon receiving a response to each of the at least one field, and prompting for a response to at least one field, the prompting varying based on the iteratively revised prioritization of all of the at least one field.

The invention, as claimed in amended claim 1, assists users with filling out, in full legal compliance, recurring sets of paperwork associated with their job that have embedded legal requirements. The invention builds artificial intelligence into the online paperwork in order to automatically support school staff in applying correctly and consistently all of the embedded procedural requirements, which alleviates training staff to remember all of the embedded requirements and to apply them correctly.

Roper discloses an individual education program tracking system that provides an automated means for creating and administering an individual education plan. However, the system in Roper merely allows for the creation of the forms that may be required so that a form, "once selected by the user . . .allows the user of the system to create a new . . . record." (underlining added) (See column 8, lines 43-46, column 10, lines 48-51).

Applicants submit that Roper does not describe or suggest at least the limitation of, iteratively revising the prioritization of all of the at least one field upon receiving a response to each of the at least one field, and prompting for a response to at least one field, the prompting varying based on the iteratively revised prioritization of all of the at least one field, as claimed in claim 1, as amended.

For at least these reasons, Applicants submit that claim 1, as amended, is allowable over the cited prior art. For similar reasons, Applicants submit that claims 21, 22, and 33 are likewise allowable.

As claims 1 and 22 are allowable, Applicants submit that claims 2-20 and 23-32, which depend from allowable claims 1 and 22, are likewise allowable over the cited art.

Conclusion

In view of the above, the Applicant respectfully submits that each of claims 1-33 recites subject matter that is neither disclosed nor suggested in the cited prior art. Applicants also submit that the subject matter is more than sufficient to render the claims non-obvious to a person of ordinary skill in the art, and therefore respectfully request that claims 1-33 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing docket number 026063-00014.

Respectfully submitted,

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